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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,293	09/16/2005	Munetake Ebihara	277771US6PCT	5131
22850	7590	07/30/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			SU, EMILE	
			ART UNIT	PAPER NUMBER
			4156	
			NOTIFICATION DATE	DELIVERY MODE
			07/30/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/549,293	Applicant(s) EBIHARA ET AL.	
	Examiner EMILE SU	Art Unit 4156	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/16/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/16/2008, 10/18/2007, 9/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to U.S. Application No. 10549293 filed on 9/16/2005.
2. **Claims 1-8** are pending.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

4. **Claims 1-4 and 8** are objected to because of the following informalities: the claim language recites "an uncopyable manner". The examiner understands this to mean the use of SecuROM™, or similar copy protection mechanism. The applicant is reminded that SecuROM™ has been bypassed before, and there is not enough creditable information to believe there will ever be "an uncopyable manner". Appropriate correction is required.
5. **Claim 8** is objected to because of the following informalities: the language of Claim 8 can be understood, but it is poorly worded. Especially the sentence, "An information processing method of an information processing apparatus into which apparatus an information recording medium on which a first execution file is recorded in a uncopyable manner is inserted". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-7** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 also recites "... and said first execution file is executed ... into an information processing apparatus." This is descriptive language to disclose the process of using the first execution file, constituting a process claim. An "information recording medium" is a product claim, and it is unclear whether the applicant intends to claim the product or claim the process. The examiner will interpret this to be a product claim for the purpose of examination.

As for Claims 2-3, see discussion of Claim 1 above.

Concerning Claim 4, see discussion of Claim 1 above. Claim 4 also recites "encrypting signature information." It is unclear whether this means encrypting portion of the content or producing a digital signature. The examiner will interpret this to mean digital signature for the purpose of examination.

Claim 5 recites "... when said information recording medium is inserted." This is indefinite language since the information recording medium can be inserted in a myriad of ways. The examiner will interpret this to mean "inserted into the apparatus" for the purpose of examination.

As for Claim 6, see above discussion of Claim 5.

Concerning Claim 7, see above discussion of Claim 5. Claim 7 also recites "encrypting signature information." It is unclear whether this means encrypting portion

of the content or producing a digital signature. The examiner will interpret this to mean digital signature for the purpose of examination.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Claim 1 recites method steps of performing the disclosed invention, but the method does not substantially refer to another statutory class. A nominal reference to an information recording medium is insufficient tie.

Claims 2-4 depend from claim 1, and are rejected since they do not introduce another statutory class.

As to Claims 5, 7, and 8, see the discussion above about 35 USC § 101. These claims, likewise, do not recite a substantive tie to another statutory class in the body of the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-3** are rejected under 35 U.S.C. 102(b) as being anticipated by Aucsmith, U.S. Patent No. 5,915,018.

Concerning Claim 1, Aucsmith discloses the invention as claimed, providing a method to secure distribution and management of cryptographic keys, comprising:

an information recording medium (i.e. DVD, see Abstract);

a first execution file (i.e. second portion 304, see Column 6, Lines 19-20);

recorded in a uncopiable manner (i.e. copy protection scheme, see Abstract, note the examiner has interpreted “uncopiable” to mean “copy protection process”);

performing an authentication process (i.e. public key, see Column 4, Lines 24-26) with a second execution file (i.e. video controller 210, see Column 5, Lines 26-29);

obtaining unique key information unique to first execution file (i.e. second key, see Column 8, Claim 12);

transmitting said unique key information to a second execution file (i.e. communication to video controller, see Column 9, Claim 15(c));

and said first execution file is executed when information recording medium is inserted into an information processing apparatus (i.e. step 402, see Column 6, Lines 55-59).

Concerning Claim 2, see the discussion of Claim 1 above. Aucsmith also teaches a process to encrypt data for unique key information to be used to encrypt encryption key information for encrypting a content (i.e. method for producing secure content, see Column 8, Claim 9).

Concerning Claim 3, see the discussion of Claims 1 and 2 above. Aucsmith also teaches to record encrypted content onto said information recording medium (i.e. writing to disc, see Column 8, Claim 8).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Aucsmith in view of Gruse et al., U.S. Patent No. 6,389,538.

Concerning Claim 4, Aucsmith discloses the invention substantially claimed, see the discussion of Claims 1-3 above. Aucsmith also disclose a process to decrypt encrypted content (i.e. decrypting the content key, see Aucsmith, Column 9, Claim 15), and the process of decrypting inherently implies the authenticity of the content that is encrypted (i.e. authentication process, see discussion of Claim 1 above). Aucsmith does not explicitly teach the method to encrypt signature information. Gruse teaches the use of public key infrastructure as a digital signature (i.e. digital signature, see Gruse, Column 6, Lines 52-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Aucsmith and Gruse to encrypt and decrypt digital signature because the use of smaller sized digital signatures is more efficient to process.

14. **Claims 5-6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aucsmith in view of Ishibashi et al., U.S. Patent No. 7,353,541.

As to Claim 5, Aucsmith teaches all the limitations (see discussion for rejection of claims 1-4 under 35 USC § 102 above) except the means for reproducing content. Ishibashi discloses a recording and reproducing apparatus (see Ishibashi, Column 7, Lines 11-26, and further see Column 7 Line 27 through Column 8 Line 9). It would have

been obvious for one of ordinary skill in the art at the time of the invention to modify Aucsmith in view of Ishibashi to establish a reproduction process because there is an increase in efficiency working through local copies of a content.

As to Claim 6, see discussions of Claims 3 and 5 above.

As to Claim 8, see discussion of Claim 5 above.

15. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Aucsmith in view of Gruse et al. as applied to Claim 4 above, and further in view of Ishibashi et al., U.S. Patent No. 7,353,541.

As to Claim 7, see discussions of Claims 4 and 6 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Garfinkel describes in paragraphs 9-10 of "Public key cryptography" the concept of public key encryption also used for authentication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571)270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES R. KYLE can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 4156
July 22, 2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4156